

REMARKS

I. Summary of the Examiner's Action

A. Claim Rejections

As set forth in paragraph 5 of the August 27 Office Action, claims 1, 3, 4 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,496,692 B1 to Shanahan (hereinafter "Shanahan" or "the Shanahan patent") in view of United States Patent No. 6,560,466 B1 to Skorko (hereinafter "Skorko" or "the Skorko patent").

As set forth in paragraph 6 of the August 27 Office Action, claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of Skorko and further in view of United States Patent No. 6,889,039 B2 to Osman (hereinafter "Osman" or "the Osman patent").

As set forth in paragraph 7 of the August 27 Office Action, claims 5, 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of United States Patent Application Publication No. US 2003/0083107 A1 to Morishima (hereinafter "Morishima" or "the Morishima application").

As set forth in paragraph 8 of the August 27 Office Action, claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of Morishima and further in view of Osman.

As set forth in paragraph 9 of the August 27 Office Action, claims 10 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of Morishima.

As set forth in paragraph 10 of the August 27 Office Action, claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of Osman and further in view of Skorko.

As set forth in paragraph 11 of the August 27 Office Action claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Shanahan and Osman patents in view of Skorko, and further in view of United States Patent Application Publication No. 2004/0266336A1 to Patsiokas *et al.* (hereinafter “Patsiokas” or “the Patsiokas application”).

As set forth in paragraph 12 of the August 27 Office Action, claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of Patsiokas.

As set forth in paragraph 13 of the August 27 Office Action, claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of Patsiokas and further in view of Osman.

These rejections are respectfully disagreed with and traversed below.

II. Applicants' Response – Claim Rejections

A. Rejection of Claims 1, 3, 4, and 14 under 35 U.S.C. § 103(a)

Applicants have amended claim 1, which now recites “wherein proximity is determined by whether other audio information is currently being provided to the user.” Applicants respectfully submit that the amendment of claim 1 is fully supported by the application as filed. *See*, for example, Application, page 2, lines 13 – 17. Accordingly, no new matter has been added.

In Applicants' invention, user proximity is determined from whether the mobile terminal is currently providing other audio information to a user. If the mobile terminal is providing other information to the user, it is assumed that the user is nearby and the other audio information is interrupted and the audio information is provided at a reduced volume. If no other audio information is being provided by the mobile terminal, it is assumed that the user is not nearby and the audio information is played out loud or at an increased volume. In contrast, Skorko has a sensor that actually detects the proximity of the user. Applicants' invention does not have such a sensor, and is therefore simpler. Applicants respectfully submit that as amended claim 1 is patentable over any of the art of record, whether taken singly or in combination. Applicants therefore request that the

rejection of claim 1 be withdrawn. Applicants also request that the rejection of claims 3, 4 and 14 be withdrawn since these claims depend from an allowable base claim.

B. Rejection of Claim 2 under 35 U.S.C. § 103(a)

Applicants respectfully submit that claim 2 is patentable as depending from an allowable base claim. Applicants therefore respectfully request that the rejection of claim 2 be withdrawn.

C. Rejection of Claims 5, 6 and 9 under 35 U.S.C. § 103(a)

Claim 5 recites, in part, “means for allowing the user to select part of the audio information, the means comprising a display for showing audio information available for selection and a cursor, the cursor for selecting a part of the audio information”. FIG. 7 of Morishima does not show a cursor being used to “select *part* of the audio information”. Rather, FIG. 7 and the accompanying description of Morishima show alternate melodies being selected. The alternate melodies are not described as being part of anything greater; rather, they are described as separate entities that are alternatives and selected as such. This is apparent from paragraphs 54 – 56 of Morishima reproduced here (emphasis added):

“On the other hand, in a case where a short cut function for changing the ring tone or the color of light of the LED for indicating an incoming call is registered in the storage unit 15 as a setting of an operation by use of the sub-

operation unit 10, the control unit 14 causes the sub-display unit 8 to display a select screen corresponding to the registered short cut function (Step S3). Here, a setting function for the ring tone is registered. Accordingly, the control unit 14 causes the sub-display unit 8 to display a select screen for selecting 'Melody 1' or 'Melody 2' as shown in the display screen 40 in FIG. 7, for example.

Next, in a case where the number of the registered sounds or melodies which can be set is more than one, the user can scroll the screen by pushing the second operation key 12 or the third operation key 13 of the sub-operation unit 10 to display a select screen for selecting 'Tone 4' or 'Melody 3' as shown in a display screen 30 or 50 in FIG. 7, for example.

If the user pushes the first operation key 11 in a state where a cursor (square portion on the display screens 30 to 50 in FIG. 7) is positioned to a desired sound or melody, the control unit 14 determines a setting of the ring tone which is designated by the cursor.”

Notably absent from this portion, or any other portion, of Morishima, is either a description or a suggestion that a part of a melody or ring tone be selected with a cursor. Accordingly, Applicants respectfully submit that claim 5 is patentable over any of the art of record, whether taken singly or in combination. Applicants therefore respectfully request that the rejection of claim 5 be withdrawn. Applicants respectfully submit that claims 6 and 9 are also patentable as depending from an allowable base claim.

D. Rejection of Claims 7 and 8 under 35 U.S.C. § 103(a)

Applicants respectfully submit that the Osman patent does not remedy the deficiency of the combination of Shanahan and Morishima identified above with respect

to claim 5. In particular, Osman neither describes nor suggests using a cursor to select part of audio information available for use as, for example, a ringing tone. Further, the operations described in Osman, column 4 relied upon by the Examiner do not select *part* of a voice memo. Rather, when the user desires to record a voice memo, the user pushes a key and speaks the voice memo, and when the user is done speaking the voice memo, the user pushes the stop button. In each instance when this is practiced the entire voice memo would be selected. In no meaningful way can it be said that *part* of a voice memo is being selected. Accordingly, Applicants respectfully submit that claims 7 and 8 are patentable over any of the art of record, whether taken singly or in combination. Applicants therefore respectfully request that the rejection of claims 7 and 8 be withdrawn.

E. Rejection of Claims 10 and 13 under 35 U.S.C. § 103(a)

Applicants have amended claim 10 to recite “means operable by the user for selecting part of the audio information, where the means is operable to receive voice commands from the user selecting part of the audio information.” Applicants respectfully submit that Osman is seen to describe audio commands for naming and managing acoustic samples, but is not seen to describe or suggest using audio commands to perform editing operations. Accordingly, Applicants respectfully submit that claim 10 is patentable over any of the art of record, whether taken singly or in combination. As a result, Applicants request that the rejection of claim 10 be withdrawn. Applicants request

that that the rejection of claim 13 be withdrawn as well as depending from an allowable base claim.

F. Rejection of Claim 11 under 35 U.S.C. § 103(a)

Applicants have amended claim 11 in a similar manner to claim 1. Accordingly, Applicants respectfully submit that claim 11 is patentable for reasons set forth with respect to claim 10 above, and further for reasons set forth with respect to claim 1. As a result, Applicants respectfully request that the rejection of claim 11 be withdrawn.

G. Rejection of Claims 12, 15 and 16 under 35 U.S.C. § 103(a)

Claim 12 recites “means for depicting how much memory remains for storing audio information, wherein the memory remaining is represented by a time duration”. The Patsiokas application neither describes nor suggest this subject matter.

Applicants respectfully submit that the Examiner is in error relying on the subject matter disclosed in the Patsiokas application. It is noted that the relied-upon portion of the Patsiokas application that published as United States Patent Application Publication No. US 2004/0266336 A1 does not appear in the Patsiokas provisional applications (copies of which are enclosed – it is noted that copies of the provisional applications were not included with the office action). In particular, the portion of paragraph 76 relied upon by the Examiner is reproduced here:

“While playing, the display shows all of the standard XM information plus the date (month and day only) and time recorded (hours and minutes

only), minutes and seconds played and minutes played and minutes and seconds remaining in memory.”

It is respectfully submitted that this subject matter does not appear in either of the Patsiokas provisional applications. Since the filing date of the Patsiokas utility application does not predate Applicants’ filing date, the Examiner can rely on the subject matter appearing in paragraph 76 of the published Patsiokas utility application only if it appears in at least one of the Patsiokas provisional applications. Applicants have carefully reviewed the Patsiokas provisional applications and it is not seen where relied-upon subject matter of paragraph 76 appears. Accordingly, since without this disclosure Examiner’s rejection is fatally deficient, Applicants respectfully request that the rejection of claim 12 be withdrawn.

Since independent claim 15 recites similar subject matter as claim 12, Applicants respectfully submit that claim 15 is also allowable. Applicants therefore respectfully request that the rejection of claim 15, and claim 16 which depends from claim 15, be withdrawn as well.

III. Conclusion

Applicants submit that in light of the foregoing amendments and remarks the application is now in condition for allowance. Applicants therefore respectfully request that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

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Date

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